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OFFICE OF PETITIONS

In re Application of: :  
Randy Burnworth :  
Application No. 10/665,930 : PETITION DECISION  
Filed: September 19, 2003 :  
Attorney Docket No.: TAYL08-00002 :

This is a decision on the petitions under 37 CFR 1.48(c) and 37 CFR 1.47(a) filed February 2, 2010, which are being treated as a petition under 37 CFR 1.48(c) and 37 CFR 1.183 to waive the requirements of 37 CFR 1.64.

The petitions are **dismissed**.

37 CFR 1.48(c), inventors added for claims to previously unclaimed subject matter requires:

- (1) A request to correct the inventorship that sets forth the desired inventorship change;
- (2) A statement from each person being added as an inventor that the addition is necessitated by amendment of the claims and that the inventorship error occurred without deceptive intention on his or her part;
- (3) An oath or declaration by the actual inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43, or § 1.47;
- (4) The processing fee set forth in § 1.17(i); and
- (5) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).

This petition is lacking items (3) and (5).

As to item (3):

Petitioner requests that the inventorship of the instant application be corrected by adding Karol Freed as a co-inventor. The originally named inventor, Randy Burnworth, who signed the originally filed declaration, is allegedly refusing to sign the replacement declaration listing both Burnworth and Freed as co-inventors. Petitions under 37 CFR 1.47 are only applicable to the initial execution of an original oath or declaration and are not applicable to supplemental oaths or declarations by the originally signing inventor. In such circumstances, the USPTO will consider

a petition under 37 CFR 1.183 requesting waiver or the requirements of 37 CFR 1.64 that each of the actual inventors execute the supplemental oath or declaration.

MPEP 603 states in part:

When an inventor who executed the original declaration is refusing or cannot be found to execute a required supplemental declaration, the requirement for that inventor to sign the supplemental declaration may be suspended or waived in accordance with 37 CFR 1.183. All available joint inventor(s) must sign the supplemental declaration on behalf of themselves, if appropriate, and on behalf of the nonsigning inventor. See MPEP § 409.03(a).

In discussing waiver requirements under 37 CFR 1.183, the Office is guided by proof similar to that required when an applicant is unavailable or refuses to sign. Petitioner indicates that the non-signing inventor Burnworth refuses to sign the replacement declaration.

MPEP 409.03(d) (II) states in part:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient.

Petitioner must demonstrate with documented evidence that an inventor refuses to join in the application after having been presented with the application papers (specification, claims, drawings and oath or declaration). There is no indication herein that joint inventor Burnworth was presented with a copy of the complete application papers for this application. From the evidence of record, it only appears that Burnworth was presented with a copy of the declaration. If Burnworth was not presented with a copy of the application papers for this application, then he could not attest that they have "reviewed and understand the application papers" and could not execute the declaration he was requested to sign. Did Burnworth receive a copy of the application papers? Unless petitioner can show that a copy of the application papers was presented to Burnworth, then petitioner will have to mail a copy of the complete application papers (specification, claims and drawings) to the last known address of Burnworth, return receipt requested. A cover letter of instructions should accompany the mailing of the application papers setting a deadline or a statement that no response will constitute a refusal. This sort of ultimatum lends support to a finding of refusal by conduct.

As to item (5):

The consent of the assignee is not acceptable. The statement of Boyd Taylor, the President of the assignee, references the reel and frame number for the assignment of Randy Burnworth to Rave Engineering Corporation and Rave Engineering Corporation to Shomi Technologies Corporation. However, Mr. Taylor's statement does not include the reel and frame number of any assignment of Karol Freed to Shomi Technologies Corporation. Thus the consent of the assignee is incomplete.

For the reasons presented above, the petitions are dismissed.


Further correspondence with respect to this matter should be addressed as follows:

By mail:        Mail Stop Petition  
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Telephone inquiries concerning this matter should be directed to Carl Friedman at (571) 272-6842.

  
David Buccini  
Petitions Examiner  
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